



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,724	07/28/2003	Timothy Effrem	MAS001	3513

7590 01/26/2006

THE LAW OFFICES OF ROUZ TABADDOR, ESQ.
1745 PENNSYLVANIA AVE. N.W.,
SUITE #205
WASHINGTON, DC 20006

EXAMINER

TALBOT, MICHAEL

ART UNIT PAPER NUMBER

3722

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/627,724

Applicant(s)

EFFREM, TIMOTHY

Examiner

Michael W. Talbot

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. The objection to the claims has been withdrawn due to Applicant's amendment filed on 13 October 2005.

Claim Rejections - 35 USC § 112

2. The rejection to the claims under the first paragraph of 35 U.S.C. 112 has been withdrawn due to Applicant's amendment filed on 13 October 2005.

Claim Rejections - 35 USC § 112

3. The rejection to the claims under the second paragraph of 35 U.S.C. 112 has been withdrawn due to Applicant's amendment filed on 13 October 2005.

Claim Rejections - 35 USC § 102 & 35 USC § 103

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1,12,14,15,18 and 19 are rejected under 35 U.S.C. 102(b) as anticipated by Warthen '445 or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sanou Drill Chuck Manufacturing Co., LTD (website: www.sanouchuck.com). Warthen '445 shows in Figures 1-3 a handpiece used with flexible shaft assemblies (10) having a generally cylindrical shaped

Art Unit: 3722

shroud (14) with a first end (left side) and a second end (right side) adapted to receive a connection device (16) and a Jacob 3-jaw chuck assembly (12) that is rotatably connected (via 18) to the interior of the shroud for securing bit. Warthen '445 shows the Jacob 3-jaw chuck assembly being adjusted by a chuck key (54) with an effective capacity of about 5 mm to above. Warthen '445 shows a first portion (left side) of the shroud having a diameter between about 25.5 mm to above and/or about 25.9 mm to above, that is being slightly greater than the outer diameter of the chuck to allow for the bearing assembly.

Alternatively, Sanou Drill Chuck Manufacturing Co., LTD discloses standard Jacob 3-jaw chuck sizes having various outer diameters ranging from 22 mm for Model J24 through 46 mm for Model J1713A with respective effective capacities ranging from 0.3 to 4 mm for Model J24 and 2 to 13 mm for Model J1713A, and everywhere in between. In view of this teaching of Sanou Drill Chuck Manufacturing Co., LTD, it would have been obvious to one of ordinary skill in the art to construct the shroud of Warthen '445 with an inner diameter being "about 25.5 mm to above" since the inner diameter of the shroud must be slightly larger than the outer diameter of the chuck in order to function properly, in this case for Model J1713A with a diameter of 46 mm, the inner diameter of the shroud must be slightly greater than 46 mm, thus meeting the claim limitation of "about 25.5 mm or above".

7. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warthen '445 in view of Sanou Drill Chuck Manufacturing Co., LTD. Warthen '445 in view of Sanou Drill Chuck Manufacturing Co., LTD does not disclose expressly the specific shroud dimensions (diameter and length) of the first portion. Instead, Warthen '445 in view of Sanou Drill Chuck Manufacturing Co., LTD is silent to these specific dimensions. At the time of the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to select a diameter of about 26 mm and a length of about 40 mm because Applicant has not

Art Unit: 3722

disclosed that the specific dimensions provide an advantage, are used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected the shroud of Warthen '445 in view of Sanou Drill Chuck Manufacturing Co., LTD and Applicant's shroud to perform equally well with either the dimensions shown by Warthen '445 in view of Sanou Drill Chuck Manufacturing Co., LTD or the claimed diameter of about 26 mm and a length of about 40 mm because both shroud constructions would provide a proper gripping surface for increased ease of handling during routine operations.

Furthermore, Applicant does not provide any criticality or unexpected results for the claimed diameter of about 26 mm and a length of about 40 mm as recited in claims 2-4.

8. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warthen '445 in view of Sanou Drill Chuck Manufacturing Co., LTD. Warthen '445 in view of Sanou Drill Chuck Manufacturing Co., LTD does not disclose expressly the specific shroud thickness. Instead, Warthen '445 in view of Sanou Drill Chuck Manufacturing Co., LTD is silent to this specific dimension. At the time of the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to select a shroud thickness of about 0.7 mm to 0.8 mm because Applicant has not disclosed that the specific thickness provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected the shroud of Warthen '445 in view of Sanou Drill Chuck Manufacturing Co., LTD and Applicant's shroud to perform equally well with either the thickness dimension shown by Warthen '445 in view of Sanou Drill Chuck Manufacturing Co., LTD or the claimed thickness of about 0.7 mm to 0.8 mm because both shroud constructions would provide proper durability and flexibility in the shroud surrounding the chuck for increased ease of handling during routine operations.

Art Unit: 3722

Furthermore, Applicant does not provide any criticality or unexpected results for the claimed thickness of about 0.7 mm to 0.8 mm as recited in claims 5 and 6.

9. Claims 7 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warthen '445 in view of Sanou Drill Chuck Manufacturing Co., LTD, further in view of Herman '716. Warthen '445 in view of Sanou Drill Chuck Manufacturing Co., LTD lacks the presence of a second portion of the shrouded wall including a plurality of grooves or ridges. Herman '716 shows in Figures 1-3 a handpiece used with flexible shaft assemblies (E) having a generally cylindrical shaped shroud (A,P,R) with a first end and a second end adapted to receive a connection device and a chuck assembly (J,L,M) which is rotatably connected (B,C,D) to the interior of the shroud. Herman '716 further shows a second portion of the shroud having a plurality of grooves/ridges. In view of this teaching of Herman '716, it would have been obvious to one of ordinary skill in the art to modify the shroud of Warthen '445 in view of Sanou Drill Chuck Manufacturing Co., LTD with the addition of a second grooved/ridged shroud portion to increase the gripping surface area of the tool for improved handling and operation.

10. Claims 8-11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warthen '445 in view of Sanou Drill Chuck Manufacturing Co., LTD, further in view of Herman '716. Warthen '445 in view of Sanou Drill Chuck Manufacturing Co., LTD, further in view of Herman '716 does not disclose expressly the specific shroud dimensions (diameter and length) of the second portion. Instead, Warthen '445 in view of Sanou Drill Chuck Manufacturing Co., LTD, further in view of Herman '716 is silent to these specific dimensions. At the time of the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to select a diameter of about 25.4 mm and a length of about 62 mm because Applicant has not disclosed that the specific dimensions provide an advantage, are used for a particular purpose, or solves a stated problem. One of ordinary skill in the art,

Art Unit: 3722

furthermore, would have expected the shroud of Warthen '445 in view of Sanou Drill Chuck Manufacturing Co., LTD, further in view of Herman '716 and Applicant's shroud to perform equally well with either the dimensions shown by Warthen '445 in view of Sanou Drill Chuck Manufacturing Co., LTD, further in view of Herman '716 or the claimed diameter of about 25.4 mm and a length of about 62 mm because both shroud constructions would provide an additional proper gripping surface for increased ease of handling during routine operations.

Furthermore, Applicant does not provide any criticality or unexpected results for the claimed diameter of about 25.4 mm and a length of about 62 mm as recited in claims 8-12.

11. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Warthen '445 in view of Sanou Drill Chuck Manufacturing Co., LTD, further in view of Herman '716. Warthen '445 in view of Sanou Drill Chuck Manufacturing Co., LTD, further in view of Herman '716 does not disclose expressly the specific shroud diameters for the first and second portions. Instead, Warthen '445 in view of Sanou Drill Chuck Manufacturing Co., LTD, further in view of Herman '716 is silent to these specific diameters. At the time of the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to select a diameter of the first portion to be about 25.5 mm to about 27.0 mm and a diameter of the second portion to be about 25.2 mm to about 25.6 mm because Applicant has not disclosed that the specific dimensions provide an advantage, are used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected the shroud of Warthen '445 in view of Sanou Drill Chuck Manufacturing Co., LTD, further in view of Herman '716 and Applicant's shroud to perform equally well with either the dimensions shown by Warthen '445 in view of Sanou Drill Chuck Manufacturing Co., LTD, further in view of Herman '716 or the claimed diameter of about 25.5 mm to about 27.0 mm for the first portion and a diameter of the 25.2 mm to about 25.6 mm for the second portion because both shroud

Art Unit: 3722

constructions would provide a proper gripping surface for increased ease of handling during routine operations.

Furthermore, Applicant does not provide any criticality or unexpected results for the claimed diameter of about 25.5 mm to about 27.0 mm for the first portion and a diameter of the 25.2 mm to about 25.6 mm for the second portion as recited in claim 13.

Allowable Subject Matter

12. The indicated allowability of claims 2-6, 8-11 and 13-19 are withdrawn in view of the newly discovered reference(s) to Warthen '445 and Sanou Drill Chuck Manufacturing Co., LTD (website: www.sanouchuck.com). Rejections based on the newly cited reference(s) are stated above.

Response to Arguments

13. Applicant's arguments, see pages 2-4 of "Response to Objections and Rejections", filed 13 October 2005, with respect to the rejection(s) of claim(s) 1,7 and 12 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art.

Conclusion

14. Any inquiry concerning the content of this communication from the examiner should be directed to Michael W. Talbot, whose telephone number is 571-272-4481. The examiner's office hours are typically 8:30am until 5:00pm, Monday through Friday. The examiner's supervisor, Mr. Boyer D. Ashley, may be reached at 571-272-4502.

In order to reduce pendency and avoid potential delays, group 3720 is encouraging FAXing of responses to Office Actions directly into the Group at FAX number 571-273-8300. This practice may be used for filling papers not requiring a fee. It may also be used for filing


Art Unit: 3722

papers, which require a fee, by applicants who authorize charges to a USPTO deposit account.

Please identify Examiner Michael W. Talbot of Art Unit 3722 at the top of your cover sheet.



MWT
Examiner
23 January 2006



BOYER D. ASHLEY
SUPERVISORY PATENT EXAMINER